

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHERRIDYTHE A. FRASER, SHAWN R. GETTEMY,
KEVIN LEE, YOON KEAN WONG, and LAWRENCE LAM

Appeal 2007-0251
Application 10/085,310
Technology Center 2600

Decided: March 12, 2007

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and HOWARD
B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-15 and 17-29, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims relate to a handheld computing device featuring interchangeable display units. Claim 15 is illustrative:

15. A handheld computing device facilitating a detachable visual display unit comprising:

a processing unit;

a power source;

a communication port for communicating with a detachable visual display unit, wherein the communication port is capable of receiving information representative of properties of the detachable visual display unit.

The Examiner relies on the following prior art reference to show unpatentability:

Moriconi

US 6,590,547 B2

Jul. 8, 2003

The rejection as presented by the Examiner is as follows:

1. Claims 1-15 and 17-29 are rejected under 35 U.S.C § 103(a) as unpatentable over Moriconi.

OPINION

Representative claim 15 purports a “handheld computing device” in the preamble. Appellants do not dispute that Moriconi describes a portable computer (e.g., a notebook computer) having structure that meets the terms recited in the body of the claim. Appellants argue, however, that (1) the preamble recitation represents a limitation of the claim and (2) the definition of “handheld computing device” distinguishes the claim over Moriconi.

(Reply Br. 4.)

Appellants submit that the claim preamble limits the structure of the claimed invention to a handheld computer that can be conveniently stored in a pocket. We find nothing in the preamble, nor in the body of the claim, that mentions storage in any pocket. The body of the claim appears to set forth a structurally complete invention, without the need to presume that the preamble further sets forth structure that is necessary for completion. The preamble thus may be read as merely providing a name for the device. The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Appellants further submit that the preamble has been relied upon during prosecution to distinguish the claimed invention from Moriconi, and thus represents a limitation, relying on a quotation from *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-09, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

In our view, the assertion of a principle relating to a patent controversy in U.S. District Court (infringement) litigation is misplaced. Here, there is no “prosecution history” because the prosecution is ongoing; the history is thus incomplete. Further, unlike proceedings in a District Court, the claims in an application may be amended to be commensurate with arguments made during prosecution, to the extent the amendments are supported by the disclosure, and thus remedy uncertainty as to the scope of a claim. “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can

uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, F.2d 893 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We are therefore not persuaded that the preamble recitation of claim 15 limits the scope of the claimed subject matter. We will, however, consider the second part of Appellants’ argument, assuming *arguendo* that “handheld computing device” represents a limitation.

Appellants suggest (Br. 8-9) that the specification provides a limiting definition for the term in controversy. Appellants point to paragraph 3 of the specification, which speaks only in general terms of “handheld computing devices,” using terms of degree such as “compact” and “small.” Appellants seem to acknowledge that the display screen sizes described by Moriconi are smaller than the size of a “standard” computer monitor, but seem to allege that the size of the displays described by Moriconi are somewhere between the size of a standard computer monitor and Appellants’ undefined “smaller” display. We do not consider the proposal to define a device by its ease of “viewing complex images of documents” (Br. 9) to be helpful in determining whether instant claim 15 distinguishes over the reference.

Appellants also submit that paragraph 22 of the specification states that a handheld computer can be “a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any such device.” (Br. 9.)

Actually, paragraph 22 of the specification describes the embodiment of processing unit 110 (Fig. 1A), rather than setting forth any definition of “handheld computing device.” Further, the section does not state that a handheld computer can be any of the things alleged by Appellants in the

Brief, but states that processing unit 110 can be “a handheld computer, a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any other such device.” The specification thus provides a list of four things that processing unit 110 may be, and then teaches that the unit is not limited to the four examples.

Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). We are not persuaded that the specification provides a useful definition for “handheld computing device.”

Appellants submit the alternative argument that the artisan would have understood the term “handheld computing device” to exclude the structures described by Moriconi. In support of that view, Appellants refer to two papers attached to the Brief in the Evidence Appendix.

One piece of evidence appears to be a printed copy from the Web page “SearchMobileComputing.com,” addressing the word “handheld.” The paper states that a handheld computer “is a computer that can conveniently be stored in a pocket (of sufficient size) and used while you’re holding it.” The next sentence indicates that “handheld computer” and “PDA” are synonymous -- i.e., “Today’s handheld computers, which are also called personal digital assistants (PDAs)” That sentence, however, is contrary to Appellants’ specification (§ 22), which teaches that a handheld computer is distinct from a PDA.

Moreover, the evidence provided from the Web page (apparently printed February 11, 2004) was last updated on September 9, 2003 (second printed page) and copyrighted “2003-2004” (third printed page). The instant application was filed February 28, 2002. The proffered evidence thus does not necessarily reflect the artisan’s understanding of the term at the time of invention (on this record, February 28, 2002).

Appellants also rely on a definition for “handheld computer” from another Web page, which designates 1997 as the date of copyright. According to the single entry, “handheld computer” is defined as “a computer small enough to be carried in your pocket.”

The “definition” is, manifestly, informal. Pockets come in a great variety of sizes, ranging from thimble-sized to very large (e.g., a pocket in an apron, a farmer’s overalls, a pocketbook, or a backpack). The entity that provided the asserted definition could not know the size of the reader’s pocket. We cannot surmise what the size of “your” pocket may be, at this time or in any future time, without knowing who “you” are and what “you” are wearing or otherwise possess. Such a “definition” would not provide reasonable notice as to what the claim might include or exclude.

Moreover, the evidence provided by Appellants may speak to the meaning of “handheld computer,” but Appellants are not claiming a “handheld computer.” The preamble of instant claim 15 purports a “handheld computing device.” Appellants’ evidence does not demonstrate that the artisan would have considered the term “handheld computing device” as excluding the laptop or notebook computers described by Moriconi.

For the foregoing reasons, we sustain the rejection of claim 15, and of claims 1, 3, 6-15, 17-19, 22, and 25-29 that are not separately argued.

Appellants argue claims 4, 5, 23, and 24 under a separate heading. (Br. 11-12.) We find that the arguments in defense of that group of claims rely on the argument that we have found unpersuasive; i.e., the proposition that the claims require a handheld computing device and Moriconi fails to teach a handheld computing device. Appellants' not showing error in the rejection, we sustain the rejection of claims 4, 5, 23, and 24.

We agree with Appellants, however, that the Examiner has not set forth a prima facie case for unpatentability with respect to the subject matter of claims 2, 20, and 21. We find no basis in this record for the position that Moriconi at column 4, lines 57 through 59, and Figures 2 and 4, would have suggested that connector 39 could be replaced with "any other appropriate type" (Answer 4 and 7). Nor has the Examiner provided any evidentiary basis for the position that a multi-pin electrical connector and a wireless interface were art-recognized equivalents at the time of the invention. (Answer 11.) We thus do not sustain the rejection as to claims 2, 20, and 21.

CONCLUSION

In summary, we affirm the rejection of claims 1, 3-15, 17-19, and 22-29 but reverse the rejection of claims 2, 20, and 21 under 35 U.S.C § 103(a) over Moriconi. The Examiner's decision is thus affirmed-in-part.

AFFIRMED-IN-PART

PGC

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